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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,575	04/13/2001	Arthur Lander	82351.0003	9101

34284 7590 06/24/2005

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EXAMINER

HOLLERAN, ANNE L

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/807,575

Applicant(s)

LANDER ET AL.

Examiner

Anne Holleran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions that are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-6, drawn to diagnostic agents comprising binding molecules that bind to glypican-1 or to therapeutic agents that bind to the extracellular region of glypican-1. Claims 1-4 will be examined with this group to the extent the binding molecule binds to glypican-1.

Group II, claims 1-4, drawn to diagnostic agents comprising binding molecules that bind to syndecan-1. Claims 1-4 will be examined with this group to the extent the binding molecule binds to syndecan-1.

Group III, claim(s) 5 and 7, drawn to therapeutic agents comprising molecules that cleave the extracellular region of glypican-1. Claim 5 will be examined with this group to the extent the molecule cleaves the extracellular region of glypican-1.

Group IV, claim(s) 5 and 8, drawn to therapeutic agents comprising molecules that suppress expression of an extracellular region of glypican-1. Claim 5 will be examined with this group to the extent the molecule suppresses expression of an extracellular region.

Group V, claim(s) 9-12, drawn to methods for diagnosing human cancer comprising contacting a sample with a molecule that binds glypican-1. Claims 9-12 will be examined with this group to the extent the methods comprise contacting a sample with a molecule that binds glypican-1.

Group VI, claim(s) 9-12, drawn to methods for diagnosing human cancer comprising contacting a sample with a molecule that binds syndecan-1. Claims 9-12 will be examined with this group to the extent the methods comprise contacting a sample with a molecule that binds syndecan-1.

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Group VII, claim(s) 13 and 14, drawn to methods for slowing the growth of human cancer cells comprising administering a molecule that binds the extracellular region of glypican-1. Claim 13 will be examined with this group to the extent the method comprises administering a molecule that binds the extracellular region of glypican-1.

Group VIII, claim(s) 13 and 15, drawn to methods for slowing the growth of human cancer cells comprising administering a molecule that cleaves the extracellular region of glypican-1. Claim 13 will be examined with this group to the extent the method comprises administering a molecule that cleaves the extracellular region of glypican-1.

Group IX, claim(s) 13 and 16, drawn to methods for slowing the growth of human cancer cells comprising administering a molecule that suppresses expression of glypican-1. Claim 13 will be examined with this group to the extent the method comprises administering a molecule that suppresses expression of glypican-1.

The inventions listed as Groups I-IX do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature of Group I is a molecule that binds to glypican-1 or to the extracellular region of glypican-1, for example an antibody that binds glypican (Mertens (Journal of Cell Biology, 132: 487-497, 1996) teaches mAbs S1 and 1G11, page 488, 2nd column).

The technical feature of Group II is a molecule that binds to syndecan-1, for example an antibody that binds to syndecan-1 (known in the art, Jalkanen (U.S. Patent 5,422,243; issued 06 June 1995) teaches antibodies that bind to syndecan-1, column 7, lines 13-54).

The technical feature of Group III is a molecule that cleaves the extracellular region of glypican-1, for example an enzyme that cleaves an extracellular region of glypican-1 (Mertens (Journal of Cell Biology, 132: 487-497, 1996) teaches phosphatidylinositol-specific phospholipase C that cleaves glypican-1, page 491, 1st column).

The technical feature of Group IV is a molecule that suppresses the expression of glypican-1, for example an anti-sense nucleic acid, which would have the complementary sequence of the nucleic acid encoding glypican-1 (sequence of cDNA encoding glypican-1 is known in the art (Veugelers, (Trends in Glycoscience and Glycotechnology 10: 145-152, 1998, March) page 149, 1st column).

The technical feature of Group V is the association between glypican protein expression and a diagnosis of human cancer.

The technical feature of Group VI is the association between syndecan-1 protein expression and a diagnosis of human cancer.

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The technical feature of Group VII is the prevention of glypican-1 function by binding of a binding molecule to glypican-1 extracellular domain.

The technical feature of Group VIII is the prevention of glypican-1 function by removal of the glypican-1 extracellular domain.

The technical feature of Group IX is the prevention of glypican-1 function by suppression of glypican-1 expression.

Glypican-1, which is common to Groups I, III, IV, V, VII, VIII and IX, is not a special technical feature that makes a contribution over the prior art as a whole because glypican-1 is known in the art as evidenced by the teachings of Mertens (Journal of Cell Biology, 132: 487-497, 1996) and of Veugelers (Trends in Glycoscience and Glycotechnology 10: 145-152, 1998, March). Also, syndecan-1, which is common to Groups II and VI, is not a special technical feature that makes a contribution over the prior art as a whole because syndecan-1 is known in the art as evidenced by the teachings of Jalkanen (U.S. Patent 5,422,243; issued 06 June 1995).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the Office should be directed to Anne Holleran, Ph.D. whose telephone number is (571) 272-0833. Examiner Holleran can normally be reached Monday through Friday, 9:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew, can be reached at (571) 272-0787.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at telephone number (703) 571-1600.

Anne L. Holleran

Patent Examiner

6/22/2005

amtharris
ALANA M. HARRIS, PH.D.
PRIMARY EXAMINER
06/22/2005